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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,154	09/21/2001	Peter Kurze	45503-00011	6323

7590

03/28/2003

Thomas R Boland
Vorys Sater Seymour and Pease
1828 L Street NW 11th Floor
Washington, DC 20036

EXAMINER

OLTMANS, ANDREW L

ART UNIT

PAPER NUMBER

1742

DATE MAILED: 03/28/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,154

Applicant(s)

KURZE ET AL.

Examiner

Andrew L Oltmans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Information Disclosure Statement

1. The references cited in the Search Report for PCT/DE00/00872 dated November 13, 2000 have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within the set period for reply to this Office action.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Fruchtnicht 3,620,939

3. Claims 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Fruchtnicht 3,620,939 (Fruchtnicht).

Fruchtnicht teaches a method of passivating (i.e. creating a chemical conversion coating on) magnesium surfaces and the resultant magnesium article (abstract) wherein the method includes contacting the surface of magnesium with a solution that includes ammonium vanadate and potassium permanganate, as recited in claim 11 (col 2, lines 60-73). Fruchtnicht teaches that

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the contact is at ambient temperature, which is encompassed by the range of temperatures recited in claim 13 (col.3, lines 18-19). The claims do not distinguish over the teachings of Fruchtnicht.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Fruchtnicht 3,620,939

5. Claims 1-2, 12 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fruchtnicht 3,620,939 (Fruchtnicht).

Fruchtnicht teaches as set forth in paragraph 3, above. Fruchtnicht further teaches that the time of contact overlaps the time of contact claimed in instant claim 14 (col 5, line 15). Fruchtnicht also teaches compositions that overlap the compositions instantly claimed in instant claims 15 and 16 (col 3, lines 64-67).

Fruchtnicht fails to meet all the limitations of the instant claims in that Fruchtnicht does not explicitly teach the oxide content of the resultant coating, the pH or the exact ranges of composition or contact time.

However, with respect to the oxide content of the resultant coating (instant claim 1), one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the process steps taught by the reference are the same as the process steps recited in the claims (i.e. contacting the surface of magnesium with a solution

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including permanganate and vanadate (Fruchtnicht: col 3, lines 60-74)) and therefore one of ordinary skill in the art would expect that the products resulting from the process taught by the reference would be the same as the product resulting from applicant's claimed process, including the product's oxide content.

"Where the claimed and prior art products are identical or substantially identical in structure or composition or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01. [emphasis added by examiner]

With respect to the pH concentration of the treatment solution (instant claim 12), one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the composition taught by the reference is substantially identical to the composition recited in the claims and therefore one of ordinary skill in the art would expect that the product taught by the reference would be the same as applicant's claimed product, including the product's pH, see MPEP 2112.01.

With respect to the composition and the time of contact, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the composition and time of contact taught by the reference overlap that of the instant claims, In re Malagari, 182 USPQ 549, and MPEP 2144.05.

With respect to the process steps recited in claim 2, it is noted that the process steps do not distinguish over any process utilized to create the claimed conversion coating because the claim uses the language "obtainable by" (claim 2, line 2). The use of the term "obtainable" does not limit the claim to the steps recited. It is further noted that an amendment to change the word "obtainable" to "obtained" would result in a product-by-process claim, see MPEP 2113. In the

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event that the applicant amends the claims to recite a product-by-process, it is noted that process limitations do not necessarily lend patentability to the claims. It is well settled that a product-by-process claim defines a product, and that when the prior art discloses a product substantially the same as that being claimed, differing only in the manner by which it is made, the burden falls upon the applicant to show that any process steps associated therewith results in a product materially different from that disclosed in the prior art. See In re Thorpe, (227 USPQ 964), In re Brown, (173 USPQ 685), In re Fessman, (180 USPQ 524) and MPEP 2113.

Japanese Patent JP 08-035073 Takatani Matsufumi in view of Pacz 1,723,067

NOTE: All references to the JP '073 reference are to the abstract or the English Language translation provided, unless otherwise indicated.

6. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent JP 08-035073 Takatani Matsufumi (JP '073) in view of Pacz 1,723,067 (Pacz).

JP '073 teaches a method of forming a conversion coating (i.e. passivating) on the surface of magnesium and the resultant article, as recited in instant claim 1-2 and 11 (abstract). JP '073 teaches that the method includes contacting the magnesium surface with a solution containing 1-10 g/l potassium permanganate, as recited in instant claim 15 (paragraph [0009]) at a temperature that encompasses the instantly claimed temperatures in instant claim 13 (paragraph [0012]), for a time encompassed by the time claimed in instant claim 14 (paragraph [0012] and [0018]) wherein the conversion coated magnesium article is subsequently treated with a polymer coating, as recited in claims 3 and 17 (paragraph [0014]).

JP '073 fails to meet all the limitations of the instant claims in that JP '073 does not explicitly teach the oxide content of the resultant coating, the pH or the inclusion of vanadate, molybdate, or tungstate.

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Pacz teaches a process of coating of magnesium (page 1, col 2, line 4) with a solution that contains molybdate or tungstate as a sodium, potassium, or ammonium salt, in a concentration that is encompassed by instant claim 16 (page 1, col 1, lines 31-37 and col 2, lines 94-102), wherein the process is inexpensive, rapid, technically convenient and safe for casual factory workers and produces a dense adherent protective coating (page 1, col 1, lines 17-25) that is attractive and is a desirable base for subsequent coatings, such as paint (page 2, col 1, lines 54-64). Pacz further teaches that the molybdate solution may also include additional reagents, such as energizing or activating reagents (page 2, col 2, lines 90-101).

With respect to the addition of molybdate, or tungstate, one of ordinary skill in the art would have found the invention to be obvious because one of ordinary skill in the art would have been motivated to add molybdate or tungstate to the solution of JP '073 in order to provide the desirable result of dense adherent protective conversion coatings (Pacz: page 1, col 1, lines 17-25) that are attractive and are a desirable base for subsequent coatings, such as paint (Pacz: page 2, col 1, lines 54-64), wherein the inclusion would provide the process with the desirable properties, while being inexpensive, rapid, technically convenient and safe for casual factory workers (Pacz: page 1, col 1, lines 17-25).

With respect to the oxide content of the resultant coating (instant claim 1), one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the process steps taught by the reference are the same as the process steps recited in the claims (i.e. contacting the surface of magnesium with a solution including permanganate and molybdate or tungstate (JP '073: abstract and Pacz: page 1, col 2, lines 90-101) and therefore one of ordinary skill in the art would expect that the products

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resulting from the process taught by the references would be the same as the product resulting from applicant's claimed process, including the product's oxide content.

"Where the claimed and prior art products are identical or substantially identical in structure or composition or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01. [emphasis added by examiner]

With respect to the pH concentration of the treatment solution (instant claim 12), one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the composition taught by the references are substantially identical to the composition recited in the claims and therefore one of ordinary skill in the art would expect that the product taught by the references would be the same as applicant's claimed product, including the product's pH, see MPEP 2112.01.

With respect to the process steps recited in claim 2 and 3, it is noted that the process steps do not distinguish over any process utilized to create the claimed conversion coating because the claim uses the language "obtainable by" (claim 2, line 2 and claim 3, line 3). The use of the term "obtainable" does not limit the claim to the steps recited. Likewise, the steps defined by claims 4-10 merely describe the process from which the article is "obtainable by". It is further noted that an amendment to change the word "obtainable" to "obtained" would result in a product-by-process claim, see MPEP 2113. In the event that the applicant amends the claims to recite a product-by-process, it is noted that process limitations do not necessarily lend patentability to the claims. It is well settled that a product-by-process claim defines a product, and that when the prior art discloses a product substantially the same as that being claimed, differing only in the manner by which it is made, the burden falls upon the applicant to show that any process steps

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associated therewith results in a product materially different from that disclosed in the prior art.

See In re Thorpe, (227 USPQ 964), In re Brown, (173 USPQ 685), In re Fessman, (180 USPQ 524) and MPEP 2113.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Oltmans whose telephone number is 703-308-2594. The examiner can normally be reached 8:30-5:00 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-873-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Andrew L. Oltmans
Examiner
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March 19, 2003